| PRE-APPEAL BRIEF REQUEST FOR REVIEW | Docket Number |
| | Q62027 |

	Application Number	Filed
Mail Stop AF	09/774,008	January 31, 2001
Commissioner for Patents	First Named Inventor	
P.O. Box 1450 Alexandria, VA 22313-1450	Sang-hyun SHIN	
	Art Unit	Examiner
	2154	Ashokkumar B. Patel

WASHINGTON OFFICE

23373

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Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal

The review is requested for the reasons(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

☑ I am an attorney or agent of record.

    Registration number   Limited Recognition No. L0212

/ Seok-Won Stuart Lee /
Signature

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December 26, 2006
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of   Docket No: Q62027

Sang-hyun SHIN

Appln. No.: 09/774,008   Group Art Unit: 2154

Confirmation No.: 2294   Examiner: Ashokkumar B. Patel

Filed: January 31, 2001

For: IP-BASED COMMUNICATION SYSTEM BETWEEN TERMINALS AND METHOD
        THEREOF

<u>PRE-APPEAL BRIEF REQUEST FOR REVIEW</u>

MAIL STOP AF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

     Pursuant to the new Pre-Appeal Brief Conference Pilot Program, and further to the

Examiner's Final Office Action dated August 25, 2006, Applicant files this Pre-Appeal Brief

Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

     Applicant turns now to the rejections at issue:

I.   Claim Rejections:

     Claims 1-9, 12, 15-18 are all the claims pending in the application. Claims 1-9, 12, 15-18

remain rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application

Publication No. 2002/0006803 (hereinafter "Mendiola").

     In view of the following discussions, Applicant respectfully submits that the rejection of

these claims is improper.

II.   Summary of Rejection:

In rejecting the claims, the Examiner alleges that Mendiola discloses each and every

element of independent claims 1, 7 and 8. Specifically, the Examiner alleges that Mendiola

discloses checking whether an IP address corresponding to the second terminal is registered

(claim 1); a controller which assigns an IP address to the second wireless terminal corresponding

to information from the IP address server, if the IP address of the second wireless terminal that is

requested by the first wireless terminal using a telephone number is not registered, and registers

the assigned IP address in the database (claim 7); and a communication module unit for sending

and receiving IP-based data, a controller for registering telephone numbers and requests for

translation of wireless telephone numbers into IP addresses, and a database for storing IP

addresses and wireless telephone numbers as determined by the controller, wherein the

communication module unit sends and receives IP-based data to and from external devices and

the external devices include IP address servers (claim 8).

In view of the following discussions, Applicant respectfully disagrees.

III.   Examiner Has Not Established A Prima Facie Case Of Obviousness:

Applicant respectfully submits that claim 1 is patentable over Mendiola because each and

every element of claim 1 is not disclosed or suggested by Mendiola.

Specifically, claim 1 recites:

A method of performing an Internet protocol (IP)-based communication between
wireless terminals, the method comprising the steps of:

(a) receiving a request for an IP address of a second terminal from a first
terminal;

(b) upon receipt of the request, checking whether an IP address corresponding to the second terminal is registered; and

(c) if the IP address is not registered, assigning an IP address to the second terminal corresponding to information from an IP address server,

wherein the first terminal is a first wireless terminal and the second terminal is a second wireless terminal.

In response to the May 22, 2006 Amendment, the Examiner asserts "the [Mendiola] reference teaches the IP address are being exchanged for the transmission of the instant messages." See Final Office Action at p. 3. In the Advisory Action of December 13, 2006, the Examiner further clarifies his position by arguing that "the assigned [Unique Identification Number] is an IP address . . . ." See Continuation Sheet of Advisory Action at p. 4. Applicant submits that the Examiner is incorrect in alleging that UIN of Mendiola discloses the IP address as recited in claim 1.

First, the IP address recited in claim 1 refers to and Internet Protocol address. See e.g., Specification at page 5, lines 2-4. Therefore, the address complies with the Internet Protocol (see e.g., Specification at page 7, lines 7-11), whereas there is nothing in Mendiola which suggests that the UIN complies with the Internet Protocol. See paragraph 117 (UIN of "12125556666").

Even assuming arguendo, that the UIN corresponds to the claimed IP address, Applicant submits that Mendiola fails to disclose or suggest a method wherein (b) upon receipt of the request, checking whether an IP address corresponding to the second terminal is registered; and (c) if the IP address is not registered, assigning an IP address to the second terminal corresponding to information from an IP address server, in combination with other elements of the claim.

Rather, Mendiola merely discloses the registering of a user and fails to disclose any sort of checking to determine whether a UIN corresponding to the user is registered. In other words, Mendiola discloses assigning a new UIN to the <u>user without determining whether any UIN has been previously assigned to the user</u>. <u>See</u> paragraph 0109.

On page 5 of the Advisory Action, the Examiner attempts to point out that paragraphs 117 and 118 of Mendiola disclose the claimed checking as recited in claim 1. Paragraph 117, however, merely discloses that "[t]he registration handler [sic] 119 of the IM server system 113 causes the UIN assigner <u>to generate a UIN to be assigned and matched to John Smith's email address</u> in the manner previously described. For this specific illustration, <u>UIN 12125556666 is matched to johnsmith@company.com</u> . . . . " Paragraph 118 merely discloses that a message is sent to a target new user. In other words, Mendiola does not to disclose that the registration handler 119 checks to see if a UIN was previously matched to John Smith's email.

Therefore, Mendiola cannot possibly disclose the checking as recited in the claim.

In addition to the above, Applicant submits that if the IP address is not registered, claim 1 recites assigning an IP address to the second terminal corresponding to information from an IP address server. Thus, claim 1 requires a particular relationship between the claimed checking in (b) with the claimed assigning in (c), a relationship which is not found in Mendiola.

For at least the above reasons, claim 1 is patentable.

Claims 7 and 8 are patentable for reasons similar to those submitted for claim 1.

Claims 2-6, 17 and 18 which depend from claim 1, claims 15 and 16, which depend from claim 7, and claims 9 and 12, which depend from claim 8, are patentable for at least the reasons submitted for their respective base claims.

IV.   Conclusion:

Applicant submits that the Examiner is attempting to arbitrarily characterize the teachings of Mendiola as corresponding to the features of claims 1, 7 and 8 in a manner that is inconsistent with the specific recitations of claim 1 and the interrelationships between the specific claim recitations. Therefore, each and every element of the independent claims 1, 7 and 8 are not disclosed by Mendiola.

Accordingly, Applicant hereby submits that the Examiner has failed to show that claims 1, 7 and 8 are anticipated by Mendiola, as required under 35 U.S.C. § 102, and hereby submits that claims 1, 7 and 8 are patentable. Claims 2-6, 17 and 18, claims 15 and 16, and claims 9 and 12, are patentable for at least the reasons submitted for their respective base claims.

Respectfully submitted,

/ Seok-Won Stuart Lee /

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5